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NORRIS, MCLAUGHLIN & MARCUS, P.A. 875 THIRD AVE 18TH FLOOR NEW YORK, NY 10022				
EXAMINER				
NELSON, MICHAEL B				
ART UNIT		PAPER NUMBER		
1794				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/578,231

**Applicant(s)**

HUSEMANN ET AL.

**Examiner**

MICHAEL B. NELSON

**Art Unit**

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 May 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/ICE)
- Paper No(s)/Mail Date 05/04/06
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_

## DETAILED ACTION

### *Specification*

1. The use of the trademarks has been noted in this application, (for example Araldite®, Page 5). They should be capitalized wherever they appear and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
  2. Ascertaining the differences between the prior art and the claims at issue.
  3. Resolving the level of ordinary skill in the pertinent art.
  4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any

evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(c), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 1, 3, 4 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Feichtmeier et al. (U.S. 6,350,791), and further in view of Kelch et al. (U.S. 2002/0068182).

Regarding claim 1, Feichtmeier et al. discloses a thermosettable adhesive composed of a thermoplastic polyester resin and an epoxy resin (C3, L5-15). Many epoxy resins are disclosed, inter alia, Araldite ® 6010, Epon ® 825 etc. (C4, L60-C5, L45), which are same as those listed as equivalent epoxy candidates in the instant spec on pages 5 and 6. The polyester resin is disclosed as being a copolyester (C5, L45-C6, L35).

Feichtmeier et al. does not disclose using a copolyester in its thermosettable adhesive with the instantly claimed properties.

Kelch et al. discloses using GRILTEX ® 9 copolyester in an hot melt adhesive layer because of its advantageous rheological properties, inter alia, low melt viscosities ([0027]-[0030]). From the instant specification (Example 1, page 9), the GRILTEX ® 9 copolyester used with the epoxy resins of Feichtmeier et al. would produce an adhesive with the instant claimed properties.

The inventions of both Feichtmeier et al. and Kelch et al. are drawn to the field of thermosetting adhesives and therefore it would have been obvious to one having ordinary skill in the art at the time of the invention to have modified the adhesive composition of Feichtmeier et

al. by using the GRILTEX ® 9 copolyester as taught by Kelch et al. for the purposes of imparting improved rheological properties.

The modified teachings of Feichtmeier et al. (i.e. using GRILTEX ® 9 as the copolyester) read on the instant claimed rheological properties in that modified Feichtmeier et al. has GRILTEX ® 9 copolyester and the epoxy equivalents of EPR 0191 at weight ratios (30% to 80% polyester and 5 to 80% epoxy, C3, L10-20) which overlap the weight ratio as disclosed in Example 1 (instant specification, page 9), which possesses the instant claimed rheological properties.

Modified Feichtmeier et al. does not explicitly disclose the specific rheological properties of the adhesive sheet as in instant claim 1. However, in light of the substantially identical adhesive composition as taught by modified Feichtmeier et al. with the instant adhesive composition from the example in the claims, it will possess the claimed properties, absent any objective evidence to the contrary. See MPEP 2112 (In re Fitzgerald, 619 F.2d 67, 70, 205 USPQ 594, 596 (CCPA 1980)).

Regarding claims 3 and 4, modified Feichtmeier et al. discloses all of the limitations as set forth above. Additionally the Feichtmeier et al. discloses a thermosettable adhesive composed of a copolyester resin (C5, L45-C6, L35) and an epoxy resin (C4, L60-C5, L45).

Regarding claim 7, Feichtmeier et al. discloses a thermosettable adhesive composed of a thermoplastic polyester resin and an epoxy resin at (C3, L5-15). Many epoxy resins are disclosed, inter alia, Araldite ® 6010, Epon ® 825 etc. (C4, L60-C5, L45), which are of the same

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as those listed as equivalent epoxy candidates in the instant spec on pages 5 and 6. The polyester resin is disclosed as being a copolyester (C5, L45-C6, L35). Feichtmeier et al. also discloses that the adhesive layer be used with a release film as a tape (C13, L20-35).

Feichtmeier et al. does not disclose using GRILTEX ® 9 copolyester in its thermosettable adhesive.

Kelch et al. discloses using GRILTEX ® 9 copolyester in an hot melt adhesive layer because of its advantageous rheological properties, inter alia, low melt viscosities ([0027]-[0030]).

The inventions of both Feichtmeier et al. and Kelch et al. are drawn to the field of thermosetting adhesives and therefore it would have been obvious to one having ordinary skill in the art at the time of the invention to have modified the adhesive composition of Feichtmeier et al. by using the GRILTEX ® 9 copolyester as taught by Kelch et al. for the purposes of imparting improved rheological properties.

The modified teachings of Feichtmeier et al. (i.e. using GRILTEX ® 9 as the copolyester) read on the instant claimed rheological properties in that modified Feichtmeier et al. has GRILTEX ® 9 copolyester and the epoxy equivalents of EPR 0191 at weight ratios (30% to 80% polyester and 5 to 80% epoxy, C3, L10-20) which overlap the weight ratio as disclosed in Example 1 (instant specification, page 9), which possesses the instant claimed rheological properties.

Modified Feichtmeier et al. does not explicitly disclose the specific rheological properties of the adhesive sheet as in instant claim 1. However, in light of the substantially identical adhesive composition as taught by modified Feichtmeier et al. with the instant adhesive composition from the example in the claims, it will possess the claimed properties, absent any

objective evidence to the contrary. See MPEP 2112 (In re Fitzgerald, 619 F.2d 67, 70, 205 USPQ 594, 596 (CCPA 1980).

6. Claims 2 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Feichtmeier et al. (U.S. 6,350,791) in view of Kelch et al. (U.S. 2002/0068182), and further in view of Vieilledent (U.S. 4,701,236).

Regarding claims 2 and 8, modified Feichtmeier et al. discloses all of the limitations as set forth above.

Modified Feichtmeier et al. does not disclose that the thickness of the film be between 10 and 100 or 20 and 80 micrometers.

Vieilledent discloses an adhesive for use with chips and cards with a thickness of 50 micrometers, which exemplifies the instant claimed ranges (C4, L40-56).

The inventions of both modified Feichtmeier et al. and Vieilledent are drawn to the field of adhesives and therefore it would have been obvious to one having ordinary skill in the art at the time of the invention to have modified the adhesive of modified Feichtmeier et al. by using the thickness as taught by Vieilledent for the purposes of using the adhesive in a way that would adequately secure a chip to a card.

7. Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Feichtmeier et al. (U.S. 6,350,791) in view of Kelch et al. (U.S. 2002/0068182), and further in view of Haghiri-Tehrani (U.S. 4,897,534).

Regarding claims 5 and 6, modified Feichtmeier et al. discloses all of the limitations as set forth above.

Modified Feichtmeier et al. does not disclose a method of using the adhesive to secure a chip to a card.

Haghiri-Tehrani discloses a method of using the adhesive to secure a chip to a card, wherein the card is a polyimide (C1, L20-30) and the chip module is PVC (C3, L35-45).

The inventions of both modified Feichtmeier et al. and Haghiri-Tehrani are drawn to the field of adhesives and therefore it would have been obvious to one having ordinary skill in the art at the time of the invention to have used the adhesive of modified Feichtmeier et al. for securing chips to cards as taught by Haghiri-Tehrani for the purposes of applying the invention to more marketable fields.

### *Conclusion*

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL B. NELSON whose telephone number is (571) 270-3877. The examiner can normally be reached on Monday through Thursday 6AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney can be reached on (571) 272-1284. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/MN/

06/04/08

/Carol Chaney/

Supervisory Patent Examiner, Art Unit 1794